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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,120	08/18/2003	David H. Sprogis	5014CON2	3480
55740 7590 10/05/2007 GAUTHIER & CONNORS, LLP 225 FRANKLIN STREET SUITE 2300 BOSTON, MA 02110			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/643,120	<b>Applicant(s)</b> SPROGIS, DAVID H.	
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :11/7/03, 10/25/04, 6/27/05, 10/31/05, 7/7/06, 12/12/06, 8/17/07.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1 (line 2), 5, the storage unit "for storing" makes it unclear whether there is actually anything positively stored in the storage unit.
- Claim 1 (line 14), are system (apparatus) claims, yet they include features which are presented as method steps rather than capabilities, rendering the claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to <perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act. In this case, it is unclear what structure is responsible for the "such that the subset will be shown prior" language. Is this actually a feature of the means for assembling?
- Claim 3 line 3, includes apparent method steps making it unclear what structure is responsible for the "data is selected...and assembled" language.

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- Claim 7, includes apparent method steps making it unclear what structure is responsible for the association with the job schedule request and the association with the show attribute.
- Claim 8, while the claim mentions job requests that refer to data stored in the storage unit, the storage unit itself has not been claimed to positively require any stored content/data.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabowsky (6,141,530) in view of Zigmond et al (6,698,020)**

Claims 27, 38, and 43: Rabowsky discloses a system and method for providing advertisement information to an audience. In particular, Rabowsky teaches that cinema files are digitized and distributed to theaters electronically for playback. A automated scheduling system is provided in order to automatically play selected advertising with the actual timed movie showings as an assembled presentation [abstract, 1:61 to 2:5, 7:37-49, 12:8-29]. However, while Rabowsky's movie advertising schedule is clearly automated in terms of playback, it is unclear how the ads are chosen for inclusion in the schedule. Zigmond et al teaches a system where video programming is provided with

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selected targeted advertising. Rabowsky teaches that conventional prior art systems choose targeted ads based upon location [2:40-43] and that targeted ads can also be selected based upon the content of the video programming, location of the showing, characteristics of the viewer, local time, etc. and then subsequently displayed at the appropriate time [4:25-48]. This selection is accomplished by automatically matching stored criteria regarding the audience, showing location with stored criteria (job requests) representing the type of audience, type of location, etc. desired by each stored advertisement submitted by the advertiser [col 10-12]. It would have been obvious to one of ordinary skill at the time of the invention to have created the advertising schedule of Rabowsky using similar techniques so that the advertisements associated with the actual movie showings could be targeted to location, programming content, time, etc. in order to provide a more compelling advertisement experience likely to be more well received by the audience than untargeted ads. Rabowsky further discloses that the scheduling system includes scheduling and playout of all trailers and data files (e.g. advertisements)(col 12, lines 8-28). While it is not explicitly disclosed that more than one job request is associated with an actual movie showing, nor that more than one actual movie showing is associated with a job request, Official Notice is taken that it is old and well known for theaters having plural projectors to display a plurality of advertisements and trailers while the audience is waiting for each projector/theater's actual movie showing to start. Likewise, it is old and well known that theaters present many of the same advertisements (e.g. advertising the theater's concession stand) and trailers to audiences awaiting the start of different actual movie

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showings. Therefore, it would have been obvious to one having ordinary skill in the art to select a plurality of job request for each actual movie showing for each of a plurality of projectors/theaters and to select a plurality of actual movie showings for each job request in Rabowsky. One would have been motivated to select more than one advertisement per actual movie showing in order to keep the audience entertained for the 5-30 minutes they are awaiting the start of the actual movie showing. One would have been motivated to select more than one actual movie showing per job request in order to preclude the need to make unique advertisements and trailers for every possible actual movie showing. In other words, there would only need to be one advertisement for the theater's concession stand, not a unique one for each actual movie showing. Official Notice is taken that it is common within the movie industry to present the advertisements, trailers, previews, etc. before showing the actual movie. This is done to ensure that the greatest number of people view this information since many people will leave the theater as soon as the movie credits begin to roll at the end of the movie. It also would make no business sense to display an advertisement for the theater's concession stand at the end of the movie. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display the non-cinema data *in advance* of the movie showing. One would have been motivated to do this for the reasons discussed above.

Regarding claim 2, it would have been obvious to one of ordinary skill at the time of the invention to have automatically assembled the advertisements with consideration for duration parameters, so that the system does not create an endless, nearly endless,

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or overly-lengthy advertising prior to the movie. No cinema with and business sense would provide hours of advertising prior to the movie showing; therefore it would have been obvious to one of ordinary skill at the time of the invention to have set time limits for the entirety of the ads by restricting a summation of each ad duration.

Regarding claim 4, Official Notice is taken that users are typically notified that requests submitted to a computer system have been properly received. It would have been obvious to one of ordinary skill at the time of the invention to have notified the job-requesting users that their requests have been properly received by the system so that the users can be confident the requests were not lost or malformed.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc